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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,568	02/27/2002	William C. Benavitz	A8130.0078/P078	5899
24998	7590	12/29/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP			DAWSON, GLENN K	
2101 L Street, NW			ART UNIT	
Washington, DC 20037			PAPER NUMBER	
			3731	
DATE MAILED: 12/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/083,568

Applicant(s)

BENAIVTZ ET AL.

Examiner

Glenn K. Dawson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 6,8 and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Green, et al.-5643319.

Green discloses a suture anchor 304 having truncated conical barbs and an insert-molded suture 306. The anchor is used to attach soft tissue to a bone. See col. 8 lines 53-63; col. 9 lines 17-23; col. 10 lines 27-47.

Claims 8,11 12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Anspach-5102421.

Anspach discloses a suture anchor and driver, wherein the driver as shown in fig. 6 has a circular recess 54 receiving a cylindrical round head 14 of a suture anchor, and a slot (bore 54 and including 56 as seen in fig. 5 and 6).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5,9,10 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anspach-'421 in view of Grafton, et al.-5964783.

Anspach discloses a suture embedded in a bore in a suture anchor. The anchor has a cylindrical round head 14 and truncated cone barbs. However, the suture being insert molded into the anchor is not disclosed. Grafton discloses that it was known to insert mold a suture into an anchor. It would have been obvious to have formed the attachment of the suture of Anspach to the anchor using insert molding techniques, as

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such produces a suture anchor/suture combination which need not be countersunk avoiding abrasion with the bone. Anspach also fails to disclose the material being bioabsorbable. Grafton teaches of a bioabsorbable suture anchor. It would have been obvious to have made the anchor of Anspach bioabsorbable so that the possibility of long-term effects would be mitigated, and no subsequent procedures would be needed to remove it if deemed necessary.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thal-5569306 in view of Grafton-'783.

Thal discloses the invention including a molded suture/anchor combination; however, the suture being "insert molded" into the anchor is not disclosed. However, Grafton discloses that it was known to insert mold a suture into an anchor. It would have been obvious to have formed the attachment of the suture of Thal to the anchor using insert molding techniques, as such produces a suture anchor/suture combination which need not be countersunk avoiding abrasion with the bone.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thal-'306 in view of Grafton, et al.-'783 as applied above, and further in view of Anspach-'421.

Thal as modified by Grafton discloses an insert-molded suture/anchor with prongs spokes or threads. However, the round cylindrical head and the truncated cone barbs are not disclosed. Anspach discloses a suture anchor with these features. It would have been obvious to have formed the anchor of Thal with a round head and truncated barbs as the head would provide a surface by which a driving member could

push the anchor into the bone; and the cone barbs would be a mere alternative mechanism for permitting insertion while preventing withdrawal, as Thal discloses that various such means are within the scope of the invention.

***Allowable Subject Matter***

Claim 7 is allowed.

***Response to Arguments***

Applicant's arguments filed 10-18-2005 have been fully considered but they are not persuasive.

Applicant argues that the shape of Anspach's anchor would not lend itself to insert molding. However, as shown by Green, a forwarding-tapering barb was known to be insert-molded. As for the serrations, the examiner contends that forming the inside surface of a mold with appropriately configured projections would easily be able to form the serrations of Anspach.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K. Dawson whose telephone number is 571-272-4694. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Glenn K Dawson  
Primary Examiner  
Art Unit 3731

Gkd  
23 December 2005

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